



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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GROUP 3600

Appellants: Per S. ANDERSEN et al.
Application No.: 09/482,462
Group No.: 3622
Filed: January 13, 2000
Examiner: Donald Champagne
For: AN ADVERTISEMENT SALES AND MANAGEMENT
SYSTEM
Attorney Docket No.: 45900-000391/US

Mail Box Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 16, 2004

REPLY BRIEF

Sir:

Appellants respectfully request an Oral Hearing under 37 C.F.R. § 1.194(b) and include the appropriate fee as specified under 37 C.F.R. §1.117(d).

REBUTTAL AND REMARKS

This reply brief is in response to the Examiner's Answer mailed June 14, 2004.

Initially, the Examiner asserts that all the independent claims 1, 19, 25 and 44 have been rejected principally against Witek et al. The Examiner argues that Witek et al. teaches every

feature except one and alleges that the Appellants have not disputed this allegation. However, Appellants assert that just because a particular issue of novelty was argued by the Appellants, this does not mean there are not other issues of novelty present in the independent claims.

Group (i): Claims 1-6, 8-13, and 16-18

The Examiner's Answer fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a). In particular, Appellants assert that the references of Witek et al. and NEXPO '97, separately or in any proper combination, fail to disclose:

a system supporting "entry, sales and management of several related advertisements in several media based on entry of a single advertisement order." as recited in claim 1.

The Examiner admits Witek et al. do not teach entry, sale and management of several related ads based on entry of a single advertisement order. The Examiner asserts that NEXPO '97 makes up for the deficiency of Witek et al. In the Examiner's Answer, the Examiner includes a quotation from NEXPO '97, p. 27 of 40, first full paragraph, to support the Examiner's argument. The quotation is as follows:

o Reuse content – easier production of multiple publications or types of documents-through a function called Multilinking. It will be possible to attach a single text or picture file to more than one Xpress layout, which makes it easier to reuse content in multiple publications, such as in zoning. If a change is later made to this file in one of its uses, that copy immediately becomes a different file and the changes don't apply to the other places it is used.

The Examiner asserts that the above quotation includes the features of entry, sale, and management of several ads based on entry of a single advertisement order "as a matter of judgement" and argues that the Appellants have provided no substantive evidence to counter the Examiner's conclusions. Appellants have argued and continue to assert that NEXPO '97 do not

teach entry, sale and management of several related ads based on entry of a single advertisement order as was admitted by the Examiner as missing in Witek et al. Appellants point out that it is the Examiner's burden to support the Examiner's argument for combining and the Examiner has clearly not done so. In particular, the Examiner has not shown that NEXPO '97 at least teaches a sale of several related ads based on entry of a single advertisement order. Instead, the Examiner attempts to support a rejection with broad brush strokes without addressing the particularities of the claim to include language regarding, at least, a "sale" of several related ads in a single advertisement order as recited in claim 1. The rejection of claim 1 is improper for at least this reason.

The Examiner goes on to argue that it is "patent and beyond dispute" that NEXPO '97 discloses reusing content in multiple publications. However, the Examiner fails to address the entry, sale, and management features of the claim sufficiently. The NEXPO '97 reference does nothing to overcome this deficiency. Instead, the QPS system of NEXPO '97 is a page design and production system – not an advertising system. As such, the QPS system has no functionality to address sales and ad booking and can therefore not support the sales feature of the present invention. Appellants submit that bits and pieces of a claim cannot be evaluated as if in a vacuum, but instead, must be read in context.

The Examiner further alleges that a motivation for combining Witek et al. with NEXPO '97 is for reasons of economy. Appellants submit that the examiner's line of reasoning is not convincing since just about anything could be combined for reasons of economy. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must

present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). The Examiner has not shown exactly what would need to be added to Witek et al. from NEXPO '97 and how such a combination would yield an economic advantage – in particular in light of the development costs involved -- or would have been obvious to one skilled in the art at the time of the Appellant's invention in light of the teachings of the references.

Furthermore, at the time of invention (and still to this date) the Federal Communications Commission (FCC) media ownership regulation severely limits common ownership of different types of media companies (e.g., newspapers and television stations). Thus, suggesting that multiple advertisements for multiple media under a single ad order would be far from obvious to one skilled in the art – simply because advertisements were (and still are) sold separately by the individual media companies. Furthermore, at the time of the Appellant's invention at least an economical motivation was not present to derive a management system according to the present invention which incorporates “different media” (such as e.g., newspapers and TV).

Moreover, if one were to follow the line of argument put forward by the Examiner as to the motivation, i.e., that a combination of Witek and NEXPO is economically driven, very high investment costs involved in developing such a system must be taken into consideration as well when considering the economical motivation. Even today, there is no apparent system that has been developed by any vendor, including the QPS software which has been under development since the late 1980s.

While, Appellants have disputed the Examiner's "economy" rationale, the Examiner maintains the economy argument and alleges that the Appellants would have the Board believe that this basic economic wisdom would come only from knowledge of the instant Application. In contrast to the Examiner's assertion and as stated in the Appellants' Appeal Brief on page 14, Appellants again assert that evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases from the nature of the problem to be solved. In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). Applicants again assert that looking at the totality of the circumstances, a combination as suggested by the Examiner is not supported by the prior art references, the knowledge of one of ordinary skill in the art, or the nature of the problem to be solved. Support for this position is in the Appellants' Appeal Brief which the Examiner has chosen not to address on its merits.

With regard to the Examiner's motivation argument, the Examiner asserts that the Appellants have provided no supporting evidence that NEXPO '97 is not combinable with the invention of Witek et al. However, Appellants point not only to Appellants' arguments in the Appeal Brief based on an In re Dembiczak analysis, which the Examiner has chosen not to rebut, but Appellants also provided a declaration by one skilled in the art as evidence that NEXPO '97 is not combinable with the invention of Witek et al.

As shown above, Appellants have submitted evidence against a prima facie case of obviousness. In contrast to the Examiner's opinion, it is the Examiner that does not provide support for a prima facie case of obviousness.

Moreover, the Examiner argues that “this is a case of technical fact more so than law”.

Appellants point out that the Examiner has used terms such as “a matter of judgement” as to whether NEXPO '97 teaches the deficiencies of Witek et al. which implies a lack of technical facts used to support the Examiner’s argument. Moreover, a 35 U.S.C. §103(a) combination is a matter of law.

Furthermore, the Examiner states that:

If the Examiner has misunderstood this admittedly slim evidence, it should be readily possible to develop new information showing that the QPS 2.0 software of NEXPO '97 vintage was not capable of . . .and especially that it could not readily be combined with the teachings of Witek et al. (emphasis added).

Here the Examiner admits that the Examiners support for the 35 U.S.C. §103(a) is “admittedly slim evidence”. The Examiner, additionally, tries to shift the burden to the Appellants to develop new information showing that the QPS 2.0 software of NEXPO '97 vintage was not capable of something and that it could not readily be combined. Initially, Appellants submit that Appellants have provided such evidence in arguments in the Appeal Brief and a declaration. Appellants further submit that the “admittedly slim evidence” is too slim to support a 35 U.S.C. §103(a) rejection.

With regard to the Examiner’s assertion in Point 21 on page 6 pertaining to the Appellant’s supposed argument regarding a “range of products”, Appellants cannot find the argument that the Examiner suggests – especially on pages 24 and 25 of the Appeal Brief.

Accordingly, Appellants maintain that the Examiner’s 35 U.S.C. §103(a) rejection with respect to Group (i) is still deficient.

Groups (ii, iii, iv)

Appellants respectfully assert ~~that these claims are allowable for at least the~~ reasons set forth above with respect to Group (i).

Groups (v, vi, vii)

The Examiner asserts that the features of Groups (v, vi, vii) add limitations that, in most cases, would be obvious even without references. Initially, Applicants submit that such an analysis is improper. For example, the Examiner suggests by using the term “most cases” that some cases would not be obvious which is not sufficient to support a 35 U.S.C. § 103(a) rejection. Moreover, based on the above, the Examiner has provided no prima facie case to support a 35 U.S.C. § 103(a) rejection for the claims of Groups (v, vi, vii). Appellants submit that such a rejection is a “piecemeal” rejection under MPEP § 707(g) and Appellants challenge the Examiner to support such an assertion as per MPEP § 2144.03(C).

Accordingly, Appellants maintain that the Examiner’s 35 U.S.C. § 103(a) rejection with respect to Groups (v, vi, vii) is still deficient.

CONCLUSION

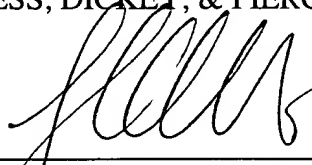
Because the Witek et al. and NEXPO '97 references do not teach or suggest the features of those in Groups (i, ii, iii, iv) and the Examiner has provided no support for the rejections of Groups (v, vi, vii), Appellants respectfully submit that claims 1-50 are patentable over Witek et al. and NEXPO '97.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By 
John A. Castellano, Reg. No. 35,094
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JAC/RFS